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APPLICATION NO.	FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIDATA
09/716,028	11/17/2000		Henry B. Lowman	P1123R1D1	CONFIRMATION NO.
9157 7590 11/12/2002 GENENTECH, INC.					
I DNA WAY				EXAMINER	
SOUTH SAN FRANCISCO, CA 94080				EWOLDT, GERALD R	
				ART UNIT	PAPER NUMBER
	-			1644	10
				DATE MAILED: 11/12/2002	1/

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/716,028

Applicant(s)

Lowman et al.

Examiner

G.R. Ewoldt

Art Unit **1644**

	The MAILING DATE of this communication appears on the	
Period	The MAILING DATE of this communication appears on the cover sheet with the correspondence address for Reply	
A SH THE	IORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM MAILING DATE OF THIS COMMUNICATION.	
- Extens	sions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the	
 If the If NO Failure Any re 	period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). ply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any patent term adjustment. See 37 CFR 1.704(b).	
Status		
1) 💢	Responsive to communication(s) filed on Aug 23, 2002	
2a) 💢	This action is FINAL . 2b) This action is non-final.	
3) 🗆	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.	
	tion of Claims	
	Claim(s) 32-39 and 41-47 is/are pending in the application.	
4	a) Of the above, claim(s) is/are withdrawn from consideration.	
5) ∟	Claim(s) is/are allowed.	
6) i X i	Claim(s) 32-39 and 41-47 is/are rejected.	
7) 🗀	Claim(s) is/are objected to.	
8) 🗀	Claims are subject to restriction and/or election requirement	
~ppiicai	tion Papers	
9) 🗌	The specification is objected to by the Examiner.	
10)	The drawing(s) filed on is/are a) accepted or b) objected to by the Examiner.	
_	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).	i
11)	The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner	
	If approved, corrected drawings are required in reply to this Office action.	
	The oath or declaration is objected to by the Examiner.	
Priority (under 35 U.S.C. §§ 119 and 120	
. كا (13	Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).	
_	All b) ☐ Some* c) ☐ None of:	l
	Certified copies of the priority documents have been received.	
	and deplication No.	
	application from the International Bureau (PCT Bule 17.2(a))	
(4) X	e the attached detailed Office action for a list of the certified copies not received.	l
a) 🗌	Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).	l
	The translation of the foreign language provisional application has been received.	
ttachmen	Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.	
	and Defense Constraints	
	e of Draftsperson's Patent Drawing Review (PTO-948) 4) Interview Summary (PTO-413) Paper No(s) 5) Notice of Informal Patent Application (PTO-152)	l
	nation Disclosure Statement(s) (PTO-1449) Paper No(s). 6) Other:	

Claims 32-39 and 41-47 are pending.

- In view of Applicant's amendment and response, filed 9/23/02, the previous rejection under the first paragraph of 35 U.S.C. 112 has been withdrawn. Additionally, all objections to the claims have been withdrawn.
- The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. assignees. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32-39 and 41-47 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,994,511 in view of U.S. Patent No. 5,622,700 (1997), for the reasons of record as set forth in Paper No. 13, mailed 6/03/02.

Applicant's arguments, filed 9/23/02, have been fully considered but they are not persuasive. Applicant argues that, "In response, Applicants respectfully submit that the Examiner's reliance upon In re Kerkhoven and M.P.E.P. § 2144.06 as authority for the rejection is misplaced," as "the present situation is not akin to that described in M.P.E.P. § 2144.06 and In re Kerkhoven." Akin or not, it remains the Examiner's position that the compositions of the instant claims are obvious in light of the claims of the '511 and '700 patents. Applicant argues that "there is simply no overlap between the presently claimed subject matter and the claims of the '700 patent." It remains the Examiner's position that there is, however, enough overlap

between the subject matter of the instant claims and the subject matter of the claims of the '511 patent in view of the subject matter of the '700 patent to maintain the rejection.

- 5. No claim is allowed.
- 6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday from 7:00 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

G.R. Ewoldt, Ph.D.
Patent Examiner
Technology Center 1600
November 7, 2002

Patrick J. Nolan, Ph.D. Primary Examiner
Technology Center 1600